

New York Law Journal



Web address: <http://www.law.com/ny>

VOLUME 230—NO. 123

WEDNESDAY, DECEMBER 24, 2003

SECOND CIRCUIT REVIEW

BY MARTIN FLUMENBAUM AND BRAD S. KARP

Copyright: Unregistered Derivative Works, Unsolicited Works

IN THIS MONTH'S column, we report on two decisions issued earlier this month by the U.S. Court of Appeals for the Second Circuit addressing copyright infringement. In the first decision, the Second Circuit held that (1) registration of a copyright in a work does not implicitly register the copyright in its derivative work and (2) a work does not violate a copyright-holder's right to control production of derivative works if it is not substantially similar to the copyrighted original. In the second decision, the Second Circuit held that there must exist evidence of a nexus between individual recipients of a copyrighted work and the alleged infringers of that work in order to raise a triable issue of fact with respect to the issue of access.

1) Derivative Works

In *Well-Made Toy Mfg. Corp. v. Goffa International Corp. and King Kullen Grocery Co., Inc.*,¹ the Second Circuit, in an opinion written by Judge Robert D. Sack and joined by Judge Guido Calabresi and Judge Nicholas G. Garaufis (U.S. District Court for the Eastern District of New York, sitting by designation), affirmed the district court's entry of summary judgment for defendants.

Plaintiff Well-Made manufactures two versions of a rag doll, a 20-inch version, the copyright for which was registered by Well-Made in 1996, and a 48-inch version. The larger version, designed two years after the design of the 20-inch doll, was achieved by enlarging the cloth patterns for the 20-inch doll on a photocopier and then adjusting the enlarged doll's proportion. Well-Made never registered a copyright in the 48-inch doll.

The same year that Well-Made began



Martin Flumenbaum

Brad S. Karp

manufacturing its 48-inch doll, defendant Goffa also began manufacturing a 48-inch rag doll that was sold through defendant King Kullen stores. Well-Made brought suit against Goffa and King Kullen, alleging that Goffa's 48-inch doll infringed its copyrights in its 20- and 48-inch dolls. The district court found, after a bench trial, that Goffa's doll was designed by copying large parts of Well-Made's 48-inch doll. However, the district court found that Goffa's 48-inch doll did not infringe Well-Made's copyright in the 20-inch doll because of the dolls' different sizes, proportions, colors and fabrics. The district court further found that it lacked subject matter jurisdiction to consider whether Goffa's doll infringed Well-Made's copyright in the larger doll because there was no separate registration of any copyright claim in that doll.

Well-Made argued on appeal that its registration of a copyright claim for the 20-inch doll was sufficient to create subject matter jurisdiction over a suit for infringement of the original doll's unregistered derivative. Pursuant to 17 USC §411(a), "no action for infringement of the copyright in any United States work shall be instituted until registration of the copyright claim has been made in accordance with this title." Well-Made based its jurisdictional argument on the court's decision in *Streetwise Maps, Inc. v. VanDam, Inc.*, 159 F3d 739 (2d Cir. 1998), which held that a copyright registration relating to a derivative work was sufficient to confer jurisdiction over an action for infringement of the pre-existing work.²

Well-Made's Rationale

The court rejected Well-Made's argument, finding that *Streetwise* did not apply because the court in that case based its holding on three grounds: the registration for the derivative work listed the original work, the plaintiff was the copyright owner of both works, and the derivative work completely subsumed the pre-existing work.³ By contrast, Well-Made's derivative 48-inch doll was not listed in any copyright registration, and the only copied expressive elements did not appear in any work whose copyright was registered. Accordingly, the court found that the district court properly concluded that it did not have subject matter jurisdiction over plaintiff's claim for copyright infringement relating to its 48-inch doll.

Well-Made also argued on appeal that Goffa's 48-inch doll was a derivative work based on Well-Made's 48-inch doll and that, because its own 48-inch doll is a derivative work based on its 20-inch doll, Goffa's 48-inch doll infringed its right to prepare derivative works based on the 20-inch doll. The Copyright Act of 1976 protects a copyright owner's exclusive right "to prepare derivative works based upon the copyrighted work."⁴ A derivative work is defined as "a work based upon one or more preexisting works, such as a translation ... abridgment, condensation, or any other form in which a work may be recast, transformed or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a 'derivative work.'"⁵

The court found that even if Goffa's doll were derivative of Well-Made's 48-inch doll, it does not follow that Goffa violated Well-Made's right to control the preparation of works derived from its 20-inch doll.⁶ The court concluded that the two dolls ceased to be substantially similar because Goffa's doll sufficiently transformed the expression of the 20-inch doll. Accordingly, Goffa's doll was not a derivative work and did not infringe the

Martin Flumenbaum and Brad S. Karp are partners, specializing in civil and criminal litigation, at Paul, Weiss, Rifkind, Wharton & Garrison LLP. Anne Raish, litigation associate at the firm, assisted in the preparation of this column.

copyright of Well-Made's 20-inch doll.

Well-Made construes the Copyright Act's provisions strictly, eschewing implicit copyright protection of an unregistered work and declining to broaden a copyright holder's right to control preparation of derivative works.

2) Establishing a Connection

In *Jorgensen v. EPIC/Sony Records, et al.*,⁷ the Second Circuit, in an opinion authored by Judge Chester J. Straub and joined by Judges Amalya J. Kearse and Reena Raggi, affirmed, in part, and reversed, in part, the district court's entry of summary judgment in favor of defendants.

Jorgensen, a songwriter proceeding pro se, brought suit against defendant music publishing companies alleging that his copyrighted song, "Long Lost Lover," was infringed by the songs "My Heart Will Go On" (Heart) and "Amazed." "Heart" was the Academy Award-winning theme song for the movie "Titanic" and was written by James Horner and Will Jennings, sung by Celine Dion and published by defendants Famous Music Corp., Fox Film Music Corp. and Blue Sky Rider Songs. Defendant Sony manufactured and distributed the Titanic soundtrack. "Amazed" was recorded by country music group Lonestar and released on its multiplatinum album, and was published by defendants Careers BMG Music Publishing, Songs of Nashville Dreamworks and Warner-Tamerlane Publishing Corp.

Mr. Jorgensen sent his song to the defendants and others through an unsolicited mass-mailing. A managing producer of BMG admitted in a sworn declaration that he received a copy of "Long Lost Lover" from Mr. Jorgensen, but stated that he did not give the song to anyone else at anytime. He also swore that he did not know and had never met the writers of the allegedly infringing song, "Amazed."

A vice president for Sony testified at his deposition that he received tapes from Mr. Jorgensen of his song "Long Lost Lover," but that he did not listen to them and believed he had discarded them. He also testified that he did not know the songwriters of the allegedly infringing song, "Heart." Mr. Jorgensen, however, testified at his deposition that he had multiple conversations with the Sony vice president about several tapes he sent him over the course of three years, one of which contained "Long Lost Lover." According to Mr. Jorgensen, the Sony vice president and his assistants repeatedly told him that they had sent his tapes to Sony's Artist and Repertoire (A & R) Department, the department responsible for finding new talent.

The Sony vice president also conceded in his deposition that, in general, it was possible that if he received a tape that he found interesting, he would pass it along to the A & R Department and that, in limited circumstances, the A & R Department may have shown materials to writers and musicians affiliated with Sony.

Defendants argued on summary judgment that plaintiff failed to make a showing that most of the defendants actually received his mailing and that, with respect to two of the defendants, failed to show that his song was forwarded to the writers of "Heart" or "Amazed." The district court entered summary judgment for the defendants, finding that "bare corporate receipt" of Mr. Jorgensen's song was not sufficient to defeat summary judgment.

In its opinion, the Second Circuit articulated the standard for defeating summary

Unsolicited mass mailing is insufficient to establish access by the writers of "Amazed" and "Heart," because plaintiff provided no documents showing he had mailed his song.

judgment on the issue of unauthorized copying of a copyrighted work. It first noted that, to prevail on a copyright infringement claim, a plaintiff must show (1) ownership of a valid copyright and (2) unauthorized copying of that work.⁸ The plaintiff can fulfill the second prong indirectly by "demonstrating that the person who composed the defendant's work had access to the copyrighted material" and that there are similarities between the two works that are indicative of copying.⁹

The court affirmed the district court's finding that an unsolicited mass mailing was insufficient to establish access by the writers of "Amazed" and "Heart" because plaintiff failed to provide any documentation — such as receipts from certified mailings — that he mailed his song. It similarly agreed that an executive's testimony that he received Mr. Jorgensen's song, but did not pass it along to anyone, was insufficient to defeat summary judgment on the issue of access.¹⁰ The court determined that "bare corporate receipt of Jorgensen's work, without any allegation of a nexus between the recipient and the alleged infringers is insufficient to raise a triable issue of fact."¹¹

The court did, however, find that Mr. Jorgensen adduced sufficient evidence of a connection between defendants Sony, Famous Music Corp. and Blue Sky Rider Songs, on the one hand, and the songwriters of "Heart," on the other.¹² It held that the plaintiff is not required to establish actual access, but need only show a "reasonable possibility of access" by the alleged infringer. It found that plaintiff succeeded in providing a "clear nexus" between the executive who admitted receiving plaintiff's song and the songwriters who composed the allegedly infringing song. The court based its finding on (1) Mr. Jorgensen's deposition testimony that the vice president had assured him that his tapes were sent to the A&R department, (2) the vice president's concession that it was possible that if he received a tape that he found interesting, he would pass it along to the A & R Department, and (3) the evidence that the A&R Department, on occasion, showed writers' and musicians' materials received by it. The court found those facts sufficient to satisfy Jorgensen's burden of showing that defendants had "a reasonable possibility of access" to the infringed work.¹³

Conclusion

Jorgensen establishes that, although a plaintiff need not establish actual access by an infringer of a copyrighted work, she must demonstrate a connection between the recipient of the work and the alleged infringer of the copyrighted work in order to withstand a motion for summary judgment.

.....●.....
(1) No. 02-7881, 2003 WL 22847088 (2d Cir. Dec. 2, 2003).

(2) *Streetwise Maps, Inc.*, 159 F3d at 747.

(3) 2003 WL 22847088, at *3.

(4) 17 USC §106(2).

(5) 17 USC §101.

(6) 2003 WL 22847088, at *4.

(7) 2003 WL 22857469, No. 02-9305 (2d Cir. Dec. 3, 2003).

(8) *Id.* at *3 (citing *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 US 340, 361 (1991)).

(9) *Id.* at *4 (quoting *Herzog v. Castle Rock Entm't*, 193 F3d 1241, 1249 (11th Cir. 1999)). The court did not address the element of similarity because defendants did not move for summary judgment on that issue. *Id.* at *8.

(10) *Id.* at *5.

(11) *Id.* at *6.

(12) *Id.* at *7.

(13) *Id.* at *7.